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CITATIONS

560-125—74——1

In the Supreme Court of the United States

OCTOBER TERM, 1974

No.

ALEXANDER P. BUTTERFIELD, ADMINISTRATOR OF THE FEDERAL AVIATION ADMINISTRATION, ET AL., PETITIONERS

v.

REUBEN B. ROBERTSON, III AND JEROME B. SIMANDLE

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

The Solicitor General, on behalf of the Administrator of the Federal Aviation Administration, the Federal Aviation Administration, the Secretary of Transportation, and the Department of Transportation, petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the District of Columbia Circuit in this case.

OPINIONS BELOW

The opinion of the court of appeals (App. A, *infra*, pp. 1A–16A) is reported at 498 F. 2d 1031. The order of the district court (App. C, *infra*, pp. 19A–20A) is not reported.

JURISDICTION

The judgment of the court of appeals (App. B, *infra,* pp. 17A–18A) was entered on May 9, 1974. A timely petition for rehearing was denied on July 11, 1974 (App. D, *infra,* p. 21A). On October 4, 1974, the Chief Justice extended the time to petition for a writ of certiorari to October 19, 1974. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

QUESTION PRESENTED

Exemption 3 of the Freedom of Information Act provides for nondisclosure of "matters that are specifically exempted from disclosure by statute." The question is whether this exemption covers all material with respect to which Congress by statute has provided for nondisclosure upon various terms, including statutes that give government officials discretion to decide whether to disclose.

STATUTES INVOLVED

Section 1104 of the Federal Aviation Act of 1958, 49 U.S.C. 1504, provides:

> Any person may make written objection to the public disclosure of information contained in any application, report, or document filed pursuant to the provisions of this chapter or of information obtained by the Board or the Administrator, pursuant to the provisions of this chapter, stating the grounds for such objection. Whenever such objection is made, the Board or Administrator shall order such information withheld from public disclosure when, in their judgment, a disclosure of such information would adversely affect the interests of

such person and is not required in the interest of the public. The Board or Administrator shall be responsible for classified information in accordance with appropriate law: *Provided,* That nothing in this section shall authorize the withholding of information by the Board or Administrator from the duly authorized committees of the Congress.

The Freedom of Information Act, 5 U.S.C. 552, provides in pertinent part:

§ 552. *Public information; agency rules, opinions, orders, records, and proceedings.*

(a) Each agency shall make available to the public information as follows:

* * * * *

(3) Except with respect to the records made available under paragraphs (1) and (2) of this subsection, each agency, on request for identifiable records made in accordance with published rules stating the time, place, fees to the extent authorized by statute, and procedure to be followed, shall make the records promptly available to any person. On complaint, the district court of the United States in the district in which the complainant resides, or has his principal place of business, or in which the agency records are situated, has jurisdiction to enjoin the agency from withholding agency records improperly withheld from the complainant. In such a case the court shall determine the matter de novo and the burden is on the agency to sustain its action. In the event of noncompliance with the order of the court, the district court may punish for contempt the responsible employee, and in the case of a uni-

formed service, the responsible member. Except as to causes the court considers of greater importance, proceedings before the district court, as authorized by this paragraph, take precedence on the docket over all other causes and shall be assigned for hearing and trial at the earliest practicable date and expedited in every way.

* * * * *

(b) This section does not apply to matters that are——

* * * * *

(3) specifically exempted from disclosure by statute;

* * * * *

STATEMENT

In this suit the plaintiffs seek, under the Freedom of Information Act (FOI Act), 5 U.S.C. 552, reports prepared by the Federal Aviation Administration (FAA) in connection with its Systemsworthiness Analysis Program (SWAP). This program, which supplements the FAA's ordinary surveillance of airlines, consists of in-depth studies by FAA investigative teams of broad areas of airlines' operations and is intended to prevent unsafe conditions from arising.[1]

[1] The current FAA SWAP handbook defines the program as follows:

"The Flight Standards Systemsworthiness Analysis Program is a systems approach to fulfill agency responsibilities for inspection and surveillance of operators having formalized systems that cannot be monitored effectively using customary surveillance techniques. It is aimed at determining the causal factors which allow a system to deteriorate rather than the symptoms that are a result of such deterioration. The task of the SWAP team is to supplement the process of surveillance

As the affidavit of the former Federal Aviation Administrator in this case stated, the "investigative team works in close cooperation with airline management to find any area of maintenance, operations, management, or overall performance which needs improvement" and, thus, "[t]he system depends upon the frank and full disclosure of the airline" (C.A. App. 44).[2]

As a result of a SWAP investigation, a report is compiled for the use of FAA officials, setting out the team's findings, discussions, comments, and recommendations concerning the systems inspected. "Information investigated and discussed in a SWAP inspection," according to the former Administrator, "includes financial and operational matters which would not customarily be released to the public," as well as material "which would not be disclosed to competitors" (C.A. App. 44). The SWAP program, therefore, "operates with the understanding between the airlines and the FAA that the information will not be disclosed to the public" (C.A. App. 45).

After plaintiffs had requested the SWAP reports from the FAA, the Air Transport Association, on behalf of 28 airlines, wrote to the FAA (C.A. App. 100–102) asking that the reports be withheld from disclosure pursuant to Section 1104 of the Federal Aviation Act, 49 U.S.C. 1504. Section 1104 (*supra,*

with an indepth analysis of operators' systems and subsystems to determine if system objectives are being achieved." FAA Order 8000.3C, p. 1.

[2] "C.A. App." refers to the appendix in the court of appeals, a copy of which we are lodging with the Clerk.

pp. 2–3) provides that the Federal Aviation Administrator and the Civil Aeronautics Board, upon written objection to the disclosure of information obtained pursuant to the Act, may withhold such information "when, in their judgment, a disclosure of such information would adversely affect the interests of such person and is not required in the interest of the public."

In objecting to disclosure of the SWAP reports, the Air Transport Association noted that "[i]nformation freely given to the FAA SWAP team by the air carrier management personnel is not specifically required by the [Federal Aviation Regulations]" and that "[t]he present practice of non-public submissions * * * encourages a spirit of openness on the part of airline management which is vital to the promotion of aviation safety." The letter concluded that "[i]f public disclosure of the SWAP reports were made, the interests of aviation safety would be in danger of being subordinated to some degree to legal considerations in the presentation of information to the FAA" (C.A. App. 100). Acting upon this objection, the Administrator in the exercise of his authority under Section 1104, determined that the SWAP reports should be withheld from public disclosure since the "disclosure of the information contained therein would adversely affect the interests of the airline being investigated and is not required in the interest of the public" (C.A. App. 103).

The FAA advised respondents of the Administrator's determination under Section 1104, explaining that the SWAP reports were therefore "matters that

are specifically exempted from disclosure by statute" under exemption 3 of the FOI Act, 5 U.S.C. 552(b)(3) (C.A. App. 36). The FAA further stated that the reports were exempted from disclosure under exemptions 4, 5 and 7 of the Act, 5 U.S.C. 552(b)(4), (5) and (7) (C.A. App. 36–38).

In the district court the FAA renewed its contention that, *inter alia,* the SWAP reports were exempted from disclosure under exemption 3 of the FOI Act by virtue of Section 1104.[3] The district court held, however, that the SWAP reports were "public and non-exempt" (App. C, *infra,* p. 20A).[4]

On appeal, the court of appeals, in a 2–1 decision, held that the SWAP reports were not exempt pursuant to exemption 3 and remanded the case for consideration of other exemptions the FAA may wish to assert (App. A, *infra,* pp. 1A–16A). The court stated that "[t]he ordinary meaning of the language of Exemption (3) is that the statute therein referred to must itself specify the documents or categories of documents it authorizes to be withheld from public scrutiny," and that "Section 1104 of the Aviation Act fails to do this" (App. A. *infra,* p. 4A). The court

[3] The FAA also relied upon Exemptions 4, 5 and 7 of the FOI Act, 5 U.S.C. 552(b)(4), (5) and (7).

[4] Respondents also sought disclosure of Mechanical Reliability Reports (MRRs). MRRs are daily reports of mechanical malfunctions which are submitted to the FAA by aircraft operators. While he had previously declined to disclose MRRs, on January 11, 1972, the Administrator determined to permit disclosure of MRRs received after February 18, 1972. The district court's subsequent order in this case, on November 8, 1972, ordered disclosure of MRRs received prior to February 18, 1972. Petitioners did not contest this aspect of the district court's order on appeal.

concluded that since the SWAP reports "did not fall within any congressionally specified statutory category * * * [i]t would be unacceptable to hold that [the Administrator's] conclusion that disclosure of any and all of the reports requested would adversely affect the interests of each airline covered, and is not required 'in the interest of the public,' is a specific exemption by section 1104" (App. A, *infra,* pp. 4A–5A).

The court, noting that Section 1104 of the Federal Aviation Act contains a "public interest" standard, stated that the subsequently enacted FOI Act provided "the guide to the congressional intent with respect to the public interest" (App. A, *infra,* p. 11A). Because the FOI Act intended to eliminate from the Public Information Section of the Administrative Procedure Act such guidelines as "in the public interest," the court concluded that "the public interest standard of section 1104 is not a specific exemption by statute within the meaning of Exemption (3)" (App. A, *infra,* pp. 9A, 11A–12A).

Judge Robb dissented. He cited legislative history explaining that exemption 3 was designed to assure that the numerous previously enacted nondisclosure statutes would not be modified by the Freedom of Information Act. He concluded that "Section 1104 is tailored to the needs and problems of the Federal Aviation Administration" and was not "overridden or repealed by the general terms of the Freedom of Information Act" (App. A, *infra,* p. 16A).

REASONS FOR GRANTING THE WRIT

1. This case presents an important and recurring question concerning the meaning of exemption 3 to the Freedom of Information Act. That exemption excepts from the Act's disclosure requirements "matters that are specifically exempted from disclosure by statute." The question is whether, as the government contends, exemption 3 is applicable whenever, in refusing to disclose material, the government acts pursuant to a statute that provides for or permits nondisclosure. The court of appeals rejected this interpretation. It determined the applicability of the exemption on the basis of its judgment whether recognizing the confidentiality provided in the particular statute involved would further the objectives of the FOI Act.

At the time of the enactment of the FOI Act, there were nearly 100 statutes in existence which restricted disclosure in various ways. Those statutes, most of which have not been expressly repealed, provide for either mandatory[5] or discretionary nondisclosure of information. Note, *Freedom of Information: The Statute and the Regulations,* 56 Geo. L. J. 18, 33–34 (1967). The discretionary statutes differ widely and range from those, like 42 U.S.C. 1306,[6] which provide

[5] An example of a mandatory nondisclosure statute is 22 U.S.C. 987, which provides that correspondence and records of the State Department relating to the officers and employees of the Foreign Service are confidential and subject to inspection only by certain specified government officers.

[6] 42 U.S.C. 1306(a) provides in pertinent part:

"No disclosure of any * * * report * * * obtained at any time by the Secretary of Health, Education, and Welfare * * * or by any officer or employee of the Department * * * in the

for the nondisclosure of information unless government officials authorize disclosure, to those, like Section 1104, which permit disclosure unless government officials determine that the material should be kept confidential. They also vary with respect to the specificity of both the description of the material to be kept confidential and the basis upon which government officials may disclose it.[7]

As we show below, Congress was aware of these nondisclosure provisions and, by enacting exemption 3, intended to preserve all of the statutes, regardless of their terms, which specifically provided for nondisclosure of information. The court of appeals' decision in this case defeats that congressional policy. Instead of ascertaining whether, in refusing to disclose the SWAP reports, the Administrator acted pursuant to

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course of discharging their respective duties under this chapter * * * shall be made except as the Secretary * * * may by regulations prescribe."

[7] For example, 26 U.S.C. 6104(a)(1)(B) provides that the Secretary of the Treasury or his delegate, with respect to applications and supporting documents filed by tax exempt organizations, is to withhold from public inspection upon request of the organization any information "which he determines relates to any trade secret, patent, process, style of work, or apparatus, of the organization, if he determines that public disclosure of such information would adversely affect the organization."

35 U.S.C. 122 provides that information in patent applications cannot be made public by the Patent Office "unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner."

38 U.S.C. 3301 states that all files, records, reports and other papers pertaining to any claim under any law administered by the Veterans Administration is not to be disclosed except that "[t]he Administrator may release information * * * when in his judgment such release would serve a useful purpose."

a statute providing for such nondisclosure, the court of appeals undertook itself to decide whether maintaining the confidentiality of the SWAP reports, as provided in Section 1104, would further the general goals of the FOI Act.

Congress, however, did not intend the courts, in determining the applicability of exemption 3, to make such an inquiry. Rather, they are to determine only whether, apart from the FOI Act, there is a statute authorizing nondisclosure.

The approach of the court of appeals in interpreting exemption 3 in this case places in jeopardy a large number of the nondisclosure statutes that Congress intended to continue in effect when it enacted exemption 3. Since the Freedom of Information Act permits suits to compel disclosure to be brought in the district "in which the agency records are situated" (5 U.S.C. 552(a)(3)), the presence in the District of Columbia of most government agencies means that this decision is likely to have a particularly significant impact upon the administration of the Freedom of Information Act. It warrants review by this Court.

2. Neither the language nor the legislative history of exemption 3 supports the court of appeals' construction of it.

a. Exemption 3 covers "matters that are specifically exempted from disclosure by statute." Nothing in that phrase indicates or suggests that the statute which "specifically exempt[s]" matters from disclosure must either specify the particular documents thus exempted or provide for disclosure on terms that further the objectives of the FOI Act.

To the contrary, the statute in terms requires only that nondisclosure be specifically authorized by the statute, in contrast to situations where it is merely implied from the legislation or where government officials without specific statutory authority nevertheless refuse to disclose on the basis of their judgment that disclosure would be inappropriate.

Section 1104 of the Federal Aviation Act is a statute that "specifically exempt[s]" from disclosure the matters it covers. It provides that when the Civil Aeronautics Board or the Federal Aviation Administrator concludes that disclosure of information contained in any documents obtained by them under the Federal Aviation Act would adversely affect the interests of a person seeking confidential treatment "and is not required in the interest of the public," the Board or Administrator "shall order such information withheld from public disclosure." Congress has thus made the judgment that, in cases where the Board or the Administrator decides that the public interest requires that information obtained by them not be made public, the material shall be kept confidential. That is precisely the situation in which Congress intended exemption 3 to be applicable.

The court of appeals' ruling that exemption 3 covers only exemptive statutes that themselves specify the documents to be kept confidential is inconsistent with this Court's interpretation of another similarly structured exemption to the Act in *Environmental Protection Agency* v. *Mink*, 410 U.S. 73. That case involved exemption 1, which exempts from disclosure matters "specifically required by Executive order to

be kept secret in the interest of the national defense or foreign policy." 5 U.S.C. 552(b)(1). The Executive Order involved in *Mink*, No. 10501, did not refer, "specifically" or otherwise, to the six documents at issue in that case. Rather that Executive Order, like Section 1104 of the Federal Aviation Act, provided for confidential treatment of materials that had been classified by others. 410 U.S. at 82, n. 8. This Court rejected the argument that "classification of material under Executive Order 10501 is somehow insufficient for Exemption 1 purposes, or that the exemption contemplates the issuance of orders, under some other authority, for each document the Executive may want protected from disclosure under the Act" (410 U.S. at 83). Similarly, there is nothing in exemption 3 that limits its coverage to statutes that "specify the documents or categories of documents it authorizes to be withheld from public scrutiny" (App. A, *infra*, p. 4A).*

b. The legislative history of exemption 3 shows that the purpose of the exemption was to continue the effectiveness of the numerous statutes Congress previously had enacted to provide for confidential treatment of material in the government's possession.

In explaining exemption 3, the 1966 House Report stated that there are "nearly 100 statutes or parts of statutes which restrict public access to specific Gov-

* Mr. Justice Stewart noted in *Mink* that Exemption 3 is "[s]imilarly rigid" to exemption 1 and that "the only "matter" to be determined in a district court's *de novo* inquiry [under exemption 3] is the factual existence of * * * a statute, regardless of how unwise, self-protective, or inadvertent the enactment might be" (410 U.S. at 95, note).

ernment records. These would not be modified by the public records provision of S. 1160."[*] H. Rep. No. 1497, 89th Cong., 2d Sess., p. 10. This interpretation of the exemption was in accord with numerous prior expressions of congressional intent, made during the legislative consideration of the predecessor bills to the statute actually enacted, to preserve previously enacted nondisclosure statutes.

Thus, during the 1963 Senate Hearings, Senator Long, the Chairman of the Senate Subcommittee, and a leading proponent of the FOI Act, stated (Hearings before the Subcommittee on Administrative Practice and Procedure of the Senate Committee on the Judiciary, on S. 1666 and S. 1663 (in part) (Freedom of Information), 88th Cong., 1st Sess., p. 6):

> Section 3(e) of S. 1666 states that nothing in this section authorizes the withholding of information nor the limiting of public access to records except as specifically described in the measure. * * * *Statutes which curtail the availability of information to the public are not intended to be affected by the enactment of this bill.* They provide that specified records shall not be released unless authorized by law. Subsection 3(e) is not such an authorization to disclosure. It should be made clear that *this bill in no way limits statutes specifically written with the congressional intent of curtailing the flow of information* as a supplement necessary to the proper functioning of certain agencies. [Emphasis added.]

[*] S. 1160 is the Senate Bill which was enacted into law as the FOI Act.

During the 1965 hearings before the Foreign Operations and Government Information Subcommittee of the House Government Operations Committee, Congressman Moss, the Chairman of the Subcommittee and a leading proponent of the FOI Act, stated that the FOI Act would provide for the availability of information "unless it is withheld * * * by some statutory authority given by the Congress." Hearings before a Subcommittee of the House Committee on Government Operations, on H.R. 5012, *et al.* (Federal Public Records Law (Part 1)), 89th Cong., 1st Sess., p. 14. He noted that nondisclosure would be permissible under the FOI Act for matters "covered by specific statute" and that there were "some 78 statutes which confer authority for withholding of information" (*id.* at 20, 53).

Section 1104 is one of the pre-existing statutes governing nondisclosure which Congress did not intend exemption 3 to disturb. It is a statute in which Congress specifically directed the Administrator not to disclose material he has obtained under the Federal Aviation Act when disclosure would not be required in the public interest. Any doubt on that score is dispelled by the fact that an exhibit submitted during the Hearing before the Subcommittee on Constitutional Rights of the Senate Committee on the Judiciary, on Freedom of Information and Secrecy in Government conducted in 1958, 85th Cong., 2d Sess., listed Section 1104 as one of the "Statutory Provisions Restricting Disclosure of Government Information" (Section 1104 was then 49 U.S.C. 674) (pp. 985–987, 1017).

3. The failure of the courts of appeals to recognize that in applying exemption 3 their function is to determine only whether there is a statute requiring or authorizing the confidentiality of the material involved has led to uncertainty and confusion among the circuits over the standards for applying that exemption.[10]

In *Stretch* v. *Weinberger*, 495 F. 2d 639, the Court of Appeals for the Third Circuit ruled that for a statute providing for confidentiality to be within exemption 3, it must "prescribe some basis upon which the [agency] is to decide" whether to disclose material, namely, it must prescribe "standards or guides through which legislative judgment would be reflected in the making of administrative exemptions" (495 F. 2d at 640). It held that exemption 3 does not apply to documents covered by 42 U.S.C. 1306(a) (*supra*, n. 6), which itself provides no guidelines governing the Secretary of Health, Education, and Welfare's action in making public certain reports

[10] The court of appeals in this case was of the view that one of the deficiencies of Section 1104 was that it does not provide for judicial review of a determination of nondisclosure. There is nothing in the language or legislative history of exemption 3, however, that suggests that the lack of judicial review of an administrative determination of confidentiality defeats the exemption of material that is "specifically exempted from disclosure by statute." Moreover, an order of nondisclosure by the Administrator or the Civil Aeronautics Board is judicially reviewable under 49 U.S.C. 1486.

The court of appeals in this case also distinguished other nondisclosure statutes listed in the Attorney General's Memorandum on the Public Information Section of the Administrative Procedure Act on such grounds as having a "built-in time limit" and granting "very little discretion" (App. A, *infra*, pp. 6A–7A). There is no basis in exemption 3 for such distinctions.

filed with him. Under that standard, the Third Circuit is likely to hold that exemption 3 covers the documents involved in the present case, since the touchstone for disclosure under Section 1104—whether the "disclosure of such information would adversely affect the interests of such person and is not required in the interest of the public"—provides sufficient guidelines.

The Court of Appeals for the Fourth Circuit seemingly so indicated in *Sears* v. *Gottschalk*, No. 73-1699, decided August 14, 1974 (App. E, *infra*, pp. 23A–42A). There, in discussing *Evans* v. *Department of Transportation*, *infra*, it pointed out that in Section 1104 "Congress had provided some standards for the exercise of discretion" (App. E, *infra*, p. 29A). In contrast, even though the Court of Appeals for the District of Columbia has expressed agreement with the reasoning of the Third Circuit in the *Stretch* case,[11] it has nonetheless found exemption 3 inapplicable to Section 1104.

In view of this disagreement and uncertainty among the circuits, there is bound to be further confusion and additional litigation over the meaning of exemption 3 unless this Court clarifies the issue.

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[11] *Schechter* v. *Weinberger*, No. 73-1797, decided October 3, 1974, another case involving 42 U.S.C. 1306(a). Judge MacKinnon dissented in *Schechter* on the ground that Congress was "well aware of the existence of statutes such as 1306" and that "[i]f Congress had not intended to include this statute within Exemption Three, it could easily have done so either by explicitly narrowing the coverage of the exemption or by amending Section 1306" (498 F. 2d. 1015, 1016). In *Serchuk* v. *Weinberger*, 493 F. 2d 663, the Court of Appeals for the Fifth Circuit held without opinion, citing *Stretch* v. *Weinberger*, *supra*, that Section 1306(a) was not within exemption 3.

4. In *Evans* v. *Department of Transportation,* 446 F. 2d 821 (C.A. 5), certiorari denied, 405 U.S. 918, the Federal Aviation Administration received a letter describing Evans' alleged mental disorders affecting his qualification as a commercial pilot, but not identifying Evans by name. The correspondent refused to name Evans until he had been assured in writing that his letter would be kept confidential. 446 F. 2d at 823. The Court of Appeals for the Fifth Circuit, as an alternative ground for holding that Evans could not obtain the letters under the Freedom of Information Act, ruled that exemption 3 covered the letters. Noting that exemption 3 covers "matters that are specifically exempted from disclosure by statute," it ruled that, since the identity of Evans had been given under "assurances of complete non-disclosure," Section 1104 covered the situation. Since the SWAP program involved in the present case similarly "operates with the understanding between the airlines and the FAA that the information will not be disclosed to the public" (C.A. App. 45), the Fifth Circuit apparently would treat as confidential the material that the District of Columbia Circuit in the present case ordered produced. Indeed, in *Evans,* the Fifth Circuit seemingly—and correctly—viewed its role in determining whether exemption 3 applied as limited to ascertaining whether there was a statute providing for confidential treatment; since Section 1104 was such a statute, that ended the inquiry.

The decision of the court of appeals in the present case has in effect nullified the protection of confidentiality that Section 1104 of the Federal Aviation Act

was intended to provide. The decision is likely to impair the Federal Aviation Administration's ability properly to perform its investigative functions.

Section 1104 provides important assistance to the FAA in promoting aviation safety,[12] as demonstrated by the SWAP program involved in this case. That program was based upon the frank and full voluntary disclosure by an airline of all matters, including problems and defects, to the FAA's expert inspectors so as to prevent or correct unsafe conditions before an accident occurred. If, however, those statements are to be made public, the airlines have indicated that their concern over the consequences of such disclosure will necessarily adversely affect their voluntary cooperation. Without that cooperation, the SWAP program will be seriously impaired.

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be granted.

Respectfully submitted.

ROBERT H. BORK,
Solicitor General.
CARLA A. HILLS,
Assistant Attorney General.
ALLAN ABBOT TUTTLE,
Assistant to the Solicitor General.
LEONARD SCHAITMAN,
THOMAS G. WILSON,
Attorneys.

OCTOBER 1974.

[12] The FAA has advised that since 1958, it has granted 75 requests for nondisclosure under Section 1104.

APPENDIX A

United States Court of Appeals
for the District of Columbia Circuit

No. 72-2186

REUBEN B. ROBERTSON, III, ET AL.

v.

ALEXANDER P. BUTTERFIELD, ADMINISTRATOR, FEDERAL AVIATION ADMINISTRATION, ET AL., APPELLANTS

Appeal from the United States District Court for the District of Columbia

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Decided May 9, 1974

Harold H. Titus, Jr., United States Attorney at the time the brief was filed, *Robert E. Kopp* and *Thomas G. Wilson*, Attorneys, Department of Justice, were on the brief for appellants.

Alan B. Morrison and *Ronald L. Plesser*, were on the brief for appellees.

Before BAZELON, *Chief Judge*, FAHY, *Senior Circuit Judge*, and ROBB, *Circuit Judge*.

Opinion for the Court filed by *Senior Circuit Judge* FAHY.

Dissenting opinion filed by *Circuit Judge* ROBB.

FAHY, *Senior Circuit Judge:* The appeal raises the question whether the Federal Aviation Administration

is obligated under the Freedom of Information Act, 5 U.S.C. § 552, to disclose to appellees, plaintiffs in the District Court, certain reports in the files of the Administration. These reports, compiled under what is known as the System Worthiness Analysis Program (SWAP), consist of analyses made by employees of the Administration of the operation and maintenance performance of airlines, under the responsibility of the Administration to regulate the safety of civil aeronautics.[1] Special teams of experienced inspectors make periodic visitations of airlines to inspect and analyze their safety and maintenance operations. The findings and recommendations for corrective action are disclosed to the airline management in a meeting of Administration and airline personnel. A final SWAP report is thereafter prepared, containing the findings and recommendations of the inspection team. Appellees requested but were denied access to those reports for the year 1969. While an intra-agency appeal was pending the Air Transport Association, on behalf of numerous airlines which are members, requested that the Administrator issue an order under section 1104 of the Federal Aviation Act of 1958[2] withholding SWAP reports from the public. The Ad-

[1] See section 601(a) of the Federal Aviation Act, as amended, 49 U.S.C. § 1421(a).

[2] Section 1104 of the Act reads:

"Any person may make written objection to the public disclosure of information contained in any application, report, or document filed pursuant to the provisions of this chapter or of information obtained by the Board or the Administrator, pursuant to the provisions of this chapter, stating the grounds for such objection. Whenever such objection is made, the Board or Administrator shall order such information withheld from public disclosure when, in their judgment, a disclosure of such information would adversely affect the interests of such person and is not required in the interest of the public. . . ." 49 U.S.C. § 1504 (1970).

ministrator, complying, ruled that all SWAP reports, not only those requested by appellees, but all in existence and thereafter to be compiled, should be withheld from public disclosure because "disclosure of the information contained therein would adversely affect the interests of the airline being investigated and is not required in the interest of the public."

I

Appellees' suit in the District Court for injunctive relief under the Information Act ensued. The court granted their motion for summary judgment as to Count I of the Complaint, which raised the issue as to the SWAP reports, and ordered the Administrator to release the reports, holding, "the documents sought by plaintiffs in Count I are, as a matter of law, public and non-exempt within the meaning of 5 United States Code 552. . . ." All other counts were dismissed.[3]

No other explanation of the decision appears, but it is clear from the above posture of the case that Exemption (3) of the Information Act, relied upon by appellants in the District Court, was held not to apply. That exemption protects from disclosure matters "specifically exempted from disclosure by statute." 5 U.S.C. § 552(b)(3). We are accordingly faced with the question whether Exemption (3), considered with the Administrator's action under section 1104 to which we have referred, protects the reports from disclosure as matters "specifically exempted from disclosure by statute." We think not, for reasons now explained.

[3] No appeal is before us except from the grant of summary judgment for appellees on Count 1.

II

This court has continued to adhere to the position that exemptions of the Information Act are to be narrowly construed. *Vaughn* v. *Rosen*, 484 F. 2d 820 (D.C. Cir. 1973), *cert. denied*, —— U.S. —— (1974); *Cuneo* v. *Schlesinger*, 484 F. 2d 1086 (D.C. Cir. 1973), *cert. denied*, —— U.S. —— (1974). The ordinary meaning of the language of Exemption (3) is that the statute therein referred to must itself specify the documents or categories of documents it authorizes to be withheld from public scrutiny. Section 1104 of the Aviation Act fails to do this. It is, rather, a congressional delegation to the Board or Administrator of the Aviation Authority to weigh whether a person objecting to disclosure would be adversely affected by it, and whether, even if so affected, disclosure nevertheless "is not required in the interest of the public."

In *EPA* v. *Mink*, 410 U.S. 73 (1973), the Supreme Court considered a specific exemption by statute, Exemption (1) of the Information Act itself, which exempts matters "specifically required by Executive Order to be kept secret in the interest of the national defense or foreign policy." 5 U.S.C. § 552(b)(1). The documents sought to be disclosed had been classified as secret pursuant to Executive Order 10501.[4] Exemption (1) was construed to be a specific reference by Congress itself to a definite class of documents which were not to be disclosed. 410 U.S. at 83. Their disclosure accordingly was not required. No particular class of documents as such are referred to in section 1104 of the Aviation Act. The Administrator ordered the SWAP reports not to be disclosed although they did not fall within any congressionally specified statu-

[4] This Presidential order had served as the basis for classification of information "which requires protection in the interests of national defense."

tory category. It would be unacceptable to hold that his conclusion that disclosure of any and all of the reports requested [5] would adversely affect the interests of each airline covered, and is not required "in the interest of the public," is a specific exemption by section 1104. Not only would such an interpretation overstrain the language of Congress in Exemption (3), see *Cutler et al.* v. *C.A.B.*, C.A. No. 74-8, —— F. Supp. —— (D.D.C., April 3, 1974), it would also be at odds with the history and purpose of the Information Act considered in its relationship to section 1104, a matter further to be considered.

III

A. Before doing so, we note appellants' reliance upon the *Attorney General's Memorandum On the Public Information Section of the Administrative Procedure Act* (June, 1967), which contains the following:

> Explaining exemption (3) the House Report, at page 10, notes that there are "nearly 100 statutes or parts of statutes which restrict public access to specific Government records. These would not be modified by the public records provisions of S. 1160." [6]

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[5] Aside from all past and future SWAP reports.

[6] *Attorney General's Memorandum* at 31. But the Attorney General went on to say:

"The reference to nearly 100 statutes apparently was inserted in the House report in reliance upon a survey conducted by the Administrative Conference of the United States in 1962. This survey concluded that there were somewhat less than 100 statutory provisions which specifically exempt from disclosure, prohibit disclosure except as authorized by law, provide for disclosure only as authorized by law, or otherwise protect from disclosure. The reference therefore indicates an intention to preserve whatever protection is afforded under other

Appellants analogize the Administrator's authority under section 1104 with that of the Atomic Energy Commission under 42 U.S.C. §§ 2161–2166 (1970). In this connection appellants refer to *Mink, supra,* 410 U.S. at 77–78 n.4, where it is stated that material

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statutes, whatever their terms. For examples of the variety of statement of such provisions compare 18 U.S.C. 1905; 26 U.S.C. 6103; 42 U.S.C. 2000e–8, 2161–2166; 43 U.S.C. 1398; 44 U.S.C. 397; and 50 U.S.C. 403g."

Thus, the House Report's mention of "somewhat less than 100 statutory provisions" was quite indefinite. Moreover, as we stated in *Getman* v. *N.L.R.B.*, 450 F. 2d 670, 673, n.8 (D.C. Cir. 1971), the Senate Report is to be preferred for the reason stated in *Getman.*

Appellants' reliance upon the examples given by the Attorney General of statutes which may come within Exemption (3) also is excessive. Each of them can be distinguished from section 1104 of the Aviation Act:

18 U.S.C. § 1905 is a criminal statute prohibiting unauthorized disclosure of any information by a federal employee. There is nothing in the section which prevents the operation of the Information Act. It does not fall within the ambit of Exemption (3). *M. A. Schapiro* v. *S.E.C.*, 339 F. Supp. 467 (D.D.C. 1972); *Frankel* v. *S.E.C.*, 336 F. Supp. 675 (S.D.N.Y. 1971), *rev'd on other grounds* 460 F. 2d 813 (2d Cir.), *cert, denied*, 409 U.S. 889 (1972).

26 U.S.C. § 6103 represents the congressional judgment that federal income tax returns should remain confidential except in very limited and prescribed circumstances. This statute embodies the specificity which section 1104 of the Aviation Act lacks. *Federal Sav. & Loan Insur. Corp.* v. *Krueger*, 55 F.R.D. 512, 514 (N.D.Ill. 1972).

within those provisions might come within Exemption (3). Those provisions, however, refer to "Restricted Data"; so, too, does 42 U.S.C. § 2014(y), also mentioned by appellants. We consider such references to be in contrast with the broad discretionary

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42 U.S.C. § 2000e–8(e) is similar to 18 U.S.C. § 1905, *supra*, in that it prohibits the unauthorized disclosure by any EEOC employee of information dealing with unlawful labor practices. This statute, however, has a built-in time limit to non-disclosure, for it only prohibits disclosure "prior to the institution of any [unlawful labor practice] proceeding."

42 U.S.C. §§ 2161–2166 is discussed in the body of this opinion.

43 U.S.C. § 1398 presents yet another situation different from section 1104. Section 1398 provides that confidential information submitted by witnesses before the Public Lands Commission shall remain confidential. The distinguishing mark of the section, as contrasted with section 1104, is that no discretion is vested in the Public Lands Commission.

44 U.S.C. § 397 is now codified as 44 U.S.C. §§ 2103–2111 and is quite specific with respect to the powers and duties of the Archivist of the United States and the Administrator of General Services. The statute grants very little discretion to either official regarding whether public documents should be disclosed or remain confidential. *See Nichols* v. *United States*, 460 F. 2d 671, 673–74 (10th Cir. 1972).

Finally, 50 U.S.C. § 403g concerns one aspect of the duties of the director of the Central Intelligence Agency. By this section Congress, in the interest of national security, specifically exempts the CIA from disclosing, *inter alia*, the names, positions, functions or salaries of its employees as was required by 5 U.S.C. § 654 (1958), *repealed* by Pub. L. 86–626, 74 Stat. 427 (July 12, 1960).

authority conferred by section 1104. The latter mentions no particular category of information. It applies generally to any document filed pursuant to the Aviation Act which the Board or Administrator decides to bring within the non-disclosure provisions. The Administrator's decision in this case merely repeated the congressional language and offered no supporting explanation.

Davis, *Administrative Law,* section 3A.18 (1970 Supp.) refers to Exemption (3) in its application *vel non* to the non-disclosure power of the Security and Exchange Commission, somewhat like that available to the present Administrator. Disclosure is available "only when in its [the S.E.C.'s] judgment a disclosure of such information is in the public interest." Professor Davis states that this language "perhaps" serves specifically to exempt "whatever information the Commission, acting within the power granted, decides to withhold." *Id.* The statute, 15 U.S.C. § 78x, is subject to the same analysis applicable to 42 U.S.C. §§ 2161–2166, *supra.* Section 78x(a) reads:

> Nothing in this chapter shall be construed to require . . . the revealing of *trade secrets* or *processes* in any application, report or document filed with the Commission under this chapter. (Emphasis added.)

It goes on to allow the Commission some discretion, to decide which trade secrets or processes should be disclosed in the "public interest."

B. Analyzing somewhat further the legislative history, the House Report accompanying the Information Act lists three major purposes of the legislation, including the following:

> [The Act] sets up workable standards for the categories of records which may be exempt from public disclosure, replacing the vague phrases

> "good cause found," *"in the public interest,"* and "internal management" with specific definitions of information which may be withheld. (Emphasis added.)

H.R. REP. No. 1497, 89th Cong., 2d Sess. at 2 (1966).

As we have seen, the previously enacted section 1104 of the Aviation Act vests in the Board or Administrator of the Federal Aviation Authority the discretion to judge "when . . . a disclosure of such information would adversely affect the interests of such person [requesting nondisclosure] and is not required in the interest of the public", thus containing the broad vagueness which, according to the House Report, the Information Act was designed to remove from the public disclosure section of the Administrative Procedure Act. To hold that section 1104 remained unaffected by Exemption (3) we think would contradict a stated purpose of the Information Act and violate a primary rule of statutory interpretation. *Reliance Electric Co.* v. *Emerson Electric Co.*, 404 U.S. 418, 424 (1972).

During the debate of the Information Act on the floor of the House a question arose with respect to the application of Exemption (3) to information supplied to the Bureau of Census under the statutory provisions requiring such information to remain confidential. 13 U.S.C. § 9 (1970). The Chairman of the House subcommittee in charge of the legislation stated that the census information was within Exemption (3) as material "specifically exempted from disclosure by statute." 112 CONG. REC. 1346 (1966). Section 9 of the census statute, however, had previously been interpreted by Judge Weinfeld of the United States District Court for the Southern District of New York in *United States* v. *Bethlehem Steel Corp.*, 21 F.R.D. 568 (S.D.N.Y. 1958), where he held in a comprehen-

sive opinion that, "the language of the [census] statute is clear and unambiguous," *Id.* at 569–70, and in it "Congress has recognized and created an express privilege" of confidentiality with specific statutory exceptions. *Id.* at 570, 571.

The Senate Report reflects the House's concern over governmental misuse of the APA and expresses as follows the purpose of the Information Act:

> Innumerable times it appears that information is withheld only to cover up embarrassing mistakes or irregularities and the withholding justified by such phrases in section 3 of the Administrative Procedure Act as—"requiring secrecy in the public interest," or "required for good cause to be held confidential."
>
> It is the purpose of the present bill to eliminate such phrases, to establish a general philosophy of full agency disclosure unless information is exempted under clearly delineated statutory language and to provide a court procedure by which citizens and the press may obtain information wrongfully withheld. It is important and necessary that the present void be filled. It is essential that agency personnel, and the courts as well, be given definitive guidelines in setting information policies. Standards such as "for good cause" are certainly not sufficient.

S. Rep. No. 813, 89th Cong., 1st Sess. at 3 (1965).

C. Aware as we are of the thoughts of others adduced to support appellants' position, we are nevertheless persuaded that they should not control the court's construction of the language before us. An overriding consideration is the reasonably plain statutory language[7] of Congress in Exemption (3), considered with the basic purpose of the Information Act calling for

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[7] *Gemsco, Inc.* v. *Walling*, 324 U.S. 244, 260 (1945); *Addison* v. *Holly Hill Co.*, 322 U.S. 607, 616–17 (1944).

narrow, though, of course, not artifically so, application of its non-disclosure exemptions. *Vaughn* v. *Rosen, supra.* Moreover, further consideration of the relationship between the Information Act and the earlier Aviation Act, now to be outlined in Part IV, we think is persuasive of the correctness of the decision of the District Court.

IV

Both statutes—section 1104 and the Information Act—have to do with disclosure of government information. They are *pari materia* and should be construed together so as to effectuate the over-all congressional policy. This approach is peculiarly appropriate in a case involving section 1104, in which the final statutory standard upon which disclosure turns is the public interest. The Information Act is now the basic congressional expression of the public interest with respect to information in the possession of the federal government. When a previously enacted statute, such as 1104, has provided such a standard the subsequently enacted and comprehensive Information Act, in the varied circumstances enumerated in its provisions, is the guide to the congressional intent with respect to the public interest. This view is confirmed indirectly by the Supreme Court in *Mink.* The Court there discussed the legislative development culminating in the replacement by the Information Act of section 3 of the Administrative Procedure Act. 5 U.S.C. § 1002 (1964). That section, the Court stated, fell "far short of its disclosure goals and came to be looked upon more as a withholding than a disclosure statute."[8] Continuing, the Court said that section 3 was:

[8] *See Bristol-Myers Co.* v. *F.T.C.*, 424 F. 2d 935, 938 (D.C. Cir. 1970).

> . . . plagued with vague phrases, such as that exempting from disclosure "any function of the United States requiring secrecy in the *public interest.*" (Emphasis added.)

410 U.S. at 79.

Accordingly, we believe it follows that the public interest standard of section 1104 is not a specific exemption by statute within the meaning of Exemption (3) of the Information Act.

We are not unmindful that many important regulatory statutes, such as the Federal Communications Act and the Natural Gas Act, invest agencies of government with authority to act upon the basis of the public convenience and necessity, or the public interest; but in so legislating Congress has guided action under these general standards by requiring hearings, with findings supported by evidence directed to the decisional catalyst so phrased, followed by the right of judicial review of the validity, procedurally and substantively, of the action taken. Nothing of the sort is attached to a determination of non-disclosure under section 1104. Even were we in error in holding action under that provision not within Exemption (3), such action in our opinion would require that the courts build upon the section at least procedural safeguards for review of the reasons for the determination, supported by findings to enable the court to appraise, as under the Information Act, the validity of non-disclosure.

V

In holding that Exemption (3) does not prevent disclosure of the SWAP reports we realize that appellants desire to press their claim under Exemption (7), especially in light of our decision in *Weisberg* v. *Department of Justice*, 489 F. 2d 1195 (D.C. Cir. 1973) (en banc). Therefore, we affirm the summary

judgment for appellees insofar as appellants rely upon Exemption (3) but remand the case for consideration of Exemption (7) or any other defense to disclosure appellants may raise except Exemptions (1) and (3).

Order granting summary judgment to appellees on Count 1 is affirmed, and case in other respects remanded to District court for further proceedings not inconsistent with this opinion.

ROBB, *Circuit Judge, dissenting:* The Federal Aviation Administration is required by law "to promote safety of flight of civil aircraft in air commerce" by the issuance of standards, rules and regulations. 49 U.S.C. § 1421(a). Under 49 U.S.C. § 1425(b) the Administrator is also required to employ inspectors who shall advise and cooperate with air carriers in the inspection and maintenance of aircraft, aircraft engines, propellers, and appliances used in air transportation. To carry out these mandates the FAA developed the Systemsworthiness Analysis Program (SWAP).

SWAP investigative teams composed of highly trained and experienced FAA inspectors make periodic visitations to certified air carriers to inspect and analyze their maintenance and safety operations. A SWAP inspection covers the entire operation of the carrier being studied, including such matters as flight crew training, non-flight crew training, airport and communications facilities, flight operations policies and procedures, air carrier records and crew scheduling, and check airmen and examiners. *See* SWAP HANDBOOK, FAA Order 8000.3C. The investigative team works in close cooperation with airline management to find any area of maintenance, operations, management or performance which needs improve-

ment. To facilitate cooperation and the full and frank disclosure by the airline upon which the system depends, the SWAP program operates with the understanding between the airlines and the FAA that the contents of SWAP reports will not be released to the public. FAA Order 8000.3C para. 204. The findings of a SWAP inspection team are disclosed to the operator under examination, to enable that operator to discuss them intelligently, but they are not made available to any other operator.

Against this background the airlines, invoking section 1104 of the Federal Aviation Act of 1958, 49 U.S.C. § 1504, objected to the public disclosure of SWAP reports. The airlines stated:

> As has been set forth by the FAA in a memorandum to its regions dated February 7, 1967, "The SWAP Program requires a cooperative effort on both the part of the company and FAA if it is to work effectively." Information freely given to the FAA SWAP team by air carrier management personnel is not specifically required by the FAR's [Federal Aviation Regulations].
>
> If public disclosure of the SWAP reports were made, the interests of aviation safety would be in danger of being subordinated in some degree to legal considerations in the presentation of information to the FAA. The present practice of nonpublic submissions, which includes even tentative findings and opinions as well as certain factual material, encourages a spirit of openness on the part of airline management which is vital to the promotion of aviation safety—the paramount consideration of airlines and government alike in this area.

(J.A. 100.)

The Administrator sustained the objection, holding that disclosure of SWAP reports "would adversely

affect the interests of the airline being investigated and is not required in the interest of the public." I think the Administrator's ruling was justified by exemption (3) of the Freedom of Information Act, 5 U.S.C. § 552(b)(3).

Congress did not intend the Freedom of Information Act to repeal all other statutes which restricted public access to government records. Thus, Senator Long, Chairman of the Senate Judiciary Committee's Subcommittee on Administrative Practice and Procedure, and a leading proponent of the Freedom of Information Act stated:

> It should be made clear that this bill in no way limits statutes specifically written with the congressional intent of curtailing the flow of information as a supplement necessary to the proper functioning of certain agencies.

Hearings on S. 1166 and S. 1663 (in part), Before the Subcomm. on Administrative Practice and Procedure of the Senate Judiciary Committee, 88th Cong., 1st Sess. 6 (1963). Again, in explaining exemption (3) the House Committee on Government Operations noted that there are *"nearly 100 statutes or parts of statutes which restrict public access to specific Government records. These would not be modified by the public records provisions of S. 1160."* (H.R. Rep. No. 1497, 89th Cong., 2d Sess. 10.) (Emphasis added.) Commenting on the House Report the Attorney General's memorandum on the Public Information Section of the Administrative Procedure Act (June 1967) stated:

> The reference to "nearly 100 statutes" apparently was inserted in the House report in reliance upon a survey conducted by the Administrative Conference of the United States in 1962. This survey concluded that there were somewhat less than 100 statutory provisions

> which specifically exempt from disclosure, prohibit disclosure except as authorized by law, provide for disclosure only as authorized by law, or otherwise protect from disclosure. The reference therefore indicates an intention to preserve whatever protection is afforded under other statutes, *whatever their terms.* (Emphasis added.)

Section 1104 is tailored to the needs and problems of the Federal Aviation Administration—needs and problems which are well illustrated by this case. I cannot believe that this specific statute was overridden or repealed by the general terms of the Freedom of Information Act. The earlier and specific statute should prevail over the later more general enactment. In particular, the later act should not be read to delete the "public interest" standard from every disclosure statute in which it appears—including section 1104.

The Circuit Court of Appeals for the 5th Circuit has held that exemption (3) authorizes the Federal Aviation Administration to withhold information pursuant to section 1104, 49 U.S.C. § 1504. *Evans* v. *Dept. of Transportation,* 446 F. 2d 821 (5th Cir. 1971), *cert. denied,* 405 U.S. 918 (1972). I agree.

I respectfully dissent.

APPENDIX B

United States Court of Appeals for the District of Columbia Circuit

September Term, 1973

No. 72-2186

Civil Action 1970-71

Filed May 9, 1974

REUBEN B. ROBERTSON, III, ET AL.

v.

JOHN J. SHAFFER, ADMINISTRATOR, FEDERAL AVIATION ADMINISTRATION, ET AL., APPELLANTS

Appeal from the United States District Court for the District of Columbia

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Before BAZELON, *Chief Judge*, FAHY, *Senior Circuit Judge*, and ROBB, *Circuit Judge*

JUDGMENT

This cause came on to be heard on the record on appeal from the United States District Court for the District of Columbia, and was argued by counsel. On consideration thereof, it is

ORDERED AND ADJUDGED by this Court that the order of the District Court granting summary judgment to appellees on Count 1 of the complaint is hereby affirmed, and the case in all other respects is

remanded to the District Court for further proceedings not inconsistent with the opinion filed herein this date.

Per Curiam
For the Court:

HUGH E. KLINE,
Clerk.

Date:
Opinion for the Court filed by Senior Circuit Judge Fahy.
Dissenting opinion filed by Circuit Judge Robb.

APPENDIX C

In the United States District Court for the District of Columbia

Civil Action No. 1970–71

Filed November 8, 1972

REUBEN B. ROBERTSON, III

AND

JEROME B. SIMANDLE, PLAINTIFFS

vs.

JOHN H. SHAFFER,

ADMINISTRATOR, FEDERAL AVIATION ADMINISTRATION

FEDERAL AVIATION ADMINISTRATION
AIR TRANSPORT ASSOCIATION OF AMERICA

JOHN A. VOLPE, SECRETARY, DEPARTMENT OF TRANSPORTATION

DEPARTMENT OF TRANSPORTATION, DEFENDANTS

ORDER GRANTING SUMMARY JUDGMENT AS TO COUNT I AND DISMISSING THE REMAINING COUNTS

Upon consideration of plaintiffs' motion for partial summary judgment and Federal defendants' cross-motion for partial summary judgment embracing Count I of the Complaint herein, the points and authorities, the pleadings, affidavits and exhibits in support thereof and in opposition thereto, and it appearing to the satisfaction of the Court that there is

no genuine issue of material fact in that the documents sought by plaintiffs in Count I are, as a matter of law, public and non-exempt within the meaning of 5 United States Code 552, and plaintiffs are entitled to judgment on said count as a matter of law; and upon consideration of the Motion of Federal Defendants to Dismiss or for Summary Judgment with respect to Counts II through VI of the Complaint, the points and authorities in support thereof and in opposition thereto, and it appearing to the Court that neither of said Counts states a claim upon which relief can be granted; it is by the Court this 8th day of November 1972.

ORDERED and ADJUDGED:

1. That plaintiffs' motion for partial summary judgment embracing Count I of the complaint be and the same hereby is granted and that the defendant Federal Aviation Administration grant plaintiffs and their agents immediate access to Mechanical Reliability Reports and Systemworthiness Analysis and Program Reports upon terms and conditions no more burdensome than those which are imposed upon persons connected with the airline industry.

2. That the cross-motion of Federal defendants for partial summary judgment with respect to Count I of the complaint be and the same hereby is denied.

3. That the motion of Federal Defendants to dismiss Counts II through VI of the complaint is granted and Counts II through VI are hereby dismissed each for failure to state a claim upon which relief can be granted.

4. That plaintiffs' objection to the recommendation of the assistant pre-trial examiner is overruled as moot.

/s/ JOSEPH C. WADDY, *Judge.*

APPENDIX D

United States Court of Appeals for the District of Columbia Circuit

September Term, 1973

Civil Action 1970–71

No. 72–2186

Filed July 11, 1974

REUBEN B. ROBERTSON, III, ET AL.,

v.

JOHN H. SHAFFER, ADMINISTRATOR, FEDERAL AVIATION ADMINISTRATION, ET AL., APPELLANTS

Before: BAZELON, *Chief Judge;* FAHY, *Senior Circuit Judge* and ROBB, *Circuit Judge.*

ORDER

On consideration of appellants' petition for rehearing, it is

ORDERED by the Court that appellants' aforesaid petition is denied.

Per Curiam For the Court:

HUGH E. KLINE,
Clerk.

APPENDIX E

United States Court of Appeals for the Fourth Circuit

No. 73-1699

MARY HELEN SEARS, APPELLANT

v.

ROBERT GOTTSCHALK, COMMISSIONER OF PATENTS, APPELLEE

Appeal from the United States District Court for the Eastern District of Virginia, at Alexandria. Oren R. Lewis, District Judge

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Argued March 6, 1974

Decided August 14, 1974

Before WINTER, BUTZNER and FIELD, *Circuit Judges.*

Edward S. Irons for Appellant; Thomas G. Wilson, Attorney, United States Department of Justice, (Irving Jaffe, Acting Assistant Attorney General, Brian P. Gettings, United States Attorney, Leonard Schaitman and Barbara L. Herwig, Attorneys, United States Department of Justice, on brief) for Appellees.

WINTER, *Circuit Judge:*

Suing under the Freedom of Information Act, 5 U.S.C. § 552 (FOIA), plaintiff, a patent attorney, sought to enjoin defendant from withholding "abandoned U.S. patent applications" from her and the pub-

lic. The suit was instituted because plaintiff's request to make available to her "all existing abandoned U.S. patent applications" had been denied by the defendant on the ground that the matters sought were barred from disclosure by 35 U.S.C. § 122 (1970). The district court concluded that the documents sought were exempt from compelled disclosure on the alternate grounds that they were "specifically exempted from disclosure by statute," as provided in 5 U.S.C. § 552 (b)(3), and that they contained "trade secrets and commercial or financial information obtained from a person and privileged or confidential," as provided in 5 U.S.C. § 552(b)(4). We conclude that the district court was correct in its conclusion that abandoned patent applications are statutorily exempt from the necessity of disclosure under FOIA. We perceive no constitutional obstacle to this conclusion, and we do not think that a three-judge court was required in order to reach it. We affirm the order of the district court.

I.

A patent application is, of course, an application for the grant of a patent under the provisions of 35 U.S.C. §§ 1 *et seq.* Patent applications fall into three categories: (a) those in the process of consideration by the patent office—"pending application," (b) those denied by the patent office as to which the applicant has not sought judicial review,[1] and those abandoned by formal relinquishment[2] or mere default,[3] before the patent

[1] The right to judicial review of the denial of a patent is found in 35 U.S.C. §§ 141 and 145.

[2] 37 C.F.R. §§ 1.138, 1.139.

[3] 35 U.S.C. § 133; 37 C.F.R. § 1.135. Patent applications abandoned by default may be revived, however, by a verified statement satisfying the Commissioner of Patents that "the delay was unavoidable." 37 C.F.R. § 1.137.

office has taken final action—"abandoned applications," and (c) applications which have ripened into the grant of a patent—"matured or granted applications."

Plaintiff makes no claim that "pending applications" should be available for public inspection; indeed, she readily concedes their confidentiality under 35 U.S.C. § 122. When applications mature into the grant of a patent, a copy of the specification and drawing of the patent are annexed to the patent, 35 U.S.C. § 154, and they are open to the public for inspection and copying.[4] Thus, plaintiff's request was to have access to and examine only those falling into the second category—"abandoned applications," and only those are the subject of suit.

The patent office denies access to or inspection of both pending applications and abandoned applications. As to the latter, indices of abandoned applications are maintained, and the applications themselves or a microfilm thereof have been preserved. While the record does not reflect the fact with certainty, it appears that most, if not all, abandoned applications are extant, although, as might be expected, not all could be produced without some inconvenience and expense.[5] The record indicates that some portions of abandoned applications contain trade secrets. But it is argued

[4] By 35 U.S.C. § 112, the "specification" of a patent application is "a written description of the invention, and of the manner and process of making and using it . . . and [it] shall set forth the best mode contemplated by the inventor of carrying out his invention." The completeness of the disclosure is thus manifest.

[5] 5 U.S.C. § 552(a)(3) permits an agency to exact "fees to the extent authorized by statute" as a condition precedent to making records promptly available to any person. In the instant case, it has been stipulated that plaintiff's request for inspection was "made in accordance with published rules stating the time, place, fees to the extent authorized by statute, and procedure to be followed" in compliance with § 552(a)(3).

that the evidence on this fact was received *ex parte* and we should conclude that the Commissioner of Patents has failed to satisfy the burden of proof to enable him to claim the "trade secret" exemption to disclosure. We need not concern ourselves with this contention, however, because we do not reach the district court's alternative holding that the trade secret exemption of FOIA is applicable.

II.

The legal dispute between the parties arises from two statutes. The first is FOIA, which requires each agency "on request for *identifiable records* . . . [to] make the records promptly available to any person." (Emphasis added.) 5 U.S.C. § 552(a)(3). Among the exceptions to this mandate are records "specifically exempted from disclosure by statute," § 552(b)(3). The second statute from which the dispute arises is the provision of the patent title, 35 U.S.C. § 122, which states:

> Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.

On the merits of the ultimate question, plaintiff contends that the § 122 rule of confidentiality applies only to pending applications and not to abandoned applications, and therefore the § 552(b)(3) exception to the mandate of § 552(a)(3) does not apply. Preliminarily, she asserts that § 122 is not the type of statute to qualify for the § 552(b)(3) exception, because it authorizes the Commissioner to disclose mat-

ters required to be kept confidential if he determines that disclosure is justified.[6]

Defendant argues that plaintiff's request to inspect "all existing abandoned U.S. patent applications" is not a request for "identifiable records" within the meaning of § 552(a)(3), and plaintiff's suit should be dismissed on that basis. On the merits, defendant contends that the rule of confidentiality embodied in § 122 applies to abandoned applications as well as pending applications, and that § 122 is a statute of the kind contemplated by § 552(b)(3), so that plaintiff's request is defeated by § 552(b)(3).

III.

We are not persuaded by defendant's argument that plaintiff's request to inspect was so lacking in specificity that the records sought were not "identifiable records" within the meaning of § 552(a)(3). The purpose of the "identifiability" requirement is to generate a "reasonable description enabling the Government employee to locate the requested records." *Bristol-Myers Co.* v. *F.T.C.*, 424 F. 2d 935, 938 (D.C. Cir. 1970) (quoting S. Rept. No. 813, 89th Cong., 1st Sess. at 8). Although plaintiff's request was far reaching,[7] that purpose was met. Aside from the sheer bulk of the material to which access was sought and the accompanying expense and inconvenience of making it available for inspection, defendant makes no claim that he does not know what plaintiff wishes to see or where to locate it. The case is thus different from *Irons* v. *Schuyler*, 465 F.2d 608 (D.C. Cir.

[6] Plaintiff makes other contentions which we need not describe, discuss or decide in the view that we take of a proper disposition of the case.

[7] See the factual statements in *Irons* v. *Schuyler*, 465 F. 2d 608, 611 (D.C. Cir. 1972), cert. den., 409 U.S. 1076 (1972).

1972), where access was sought to "all unpublished manuscript decisions of the Patent Office" and where it appeared that there were more than 4,780,000 files, "any of which may contain one or more manuscript decisions." In that case, inspection was denied, but the decision turned on the difficulty of locating the requested records rather than the categorical nature of the request; we, therefore, do not deem it controlling here. If otherwise locatable, the rule in this circuit is that equitable considerations of the costs, in time and money, of making records available for examination do not supply an excuse for non-production. *Ethyl Corp.* v. *Environmental Protection Agency*, 478 F. 2d 47 (4 Cir. 1973); *Wellford* v. *Hardin*, 315 F.S. 175 (D. Md. 1970), aff'd 444 F. 2d 21 (4 Cir. 1971). See also *National Cable Television Assn., Inc.* v. *F.C.C.*, 479 F. 2d 183 (D.C. Cir. 1973); *Gelman* v. *N.L.R.B.*, 450 F. 2d 670 (D.C. Cir. 1971).

IV.

Nor do we see merit in plaintiff's argument that, since the Commissioner may disclose patent applications "in such special circumstances as may be determined by the Commissioner," § 122 is not the sort of statute contemplated by the (b)(3) exception to the disclosure requirement of FOIA.[8] The question of whether a statute which confers discretion to determine whether to make records of his agency publicly available "specifically exempts from disclosure" the material over which the Administrator has discretion is not without difficulty. Professor Davis resolves this

[8] If this argument prevails, FOIA plaintiffs will be able to compel public disclosure of all applications both pending and abandoned, notwithstanding plaintiff's concession that pending applications are protected from disclosure.

question in favor of the availability of the exception.[9] He reasons that the specific intent of Congress to maintain in secret that which the administrator determines should be so maintained should not be overridden by the more general provisions of the FOIA.

We are aware of only two cases which bear directly on this question. In *Evans* v. *Dept. of Trans.*, 446 F. 2d 821 (5 Cir. 1971), the Fifth Circuit, in an alternative holding said that the (b)(3) exception was available for matters which a statute authorized an administrator to withhold if he found that

> disclosure of such information would adversely affect the interests of such person [he who provided the information to the administrator] and is not required in the interest of the public.[10]

It is noteworthy that the Congress had provided some standards for the exercise of discretion in the statute under consideration in *Evans*.

A recent Third Circuit case, drawn to our attention by post-argument memoranda, emphasizes the absence of statutory guidelines for the exercise of discretion in holding that 42 U.S.C. § 1306(a), which reads

> No disclosure of any . . . report obtained at any time by the Secretary . . . or employee of the Department . . . in the course of discharging their duties under this chapter [the chapter on social security] shall be made except as the Secretary . . . may by regulation prescribe,

will not support the (b)(3) exception. *Stretch* v. *Weinberger*, F. 2d ——, No. 73–1547 (3 Cir. March 5, 1974). However, in *Stretch*, the court placed equal emphasis on the lack of specificity in the phrase "any

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[9] Davis, Administrative Law, § 3A.18 (1970 Supp.).

[10] 49 U.S.C. § 1504 (1970).

record"—the definition of the matters to be kept confidential within the Secretary's discretion. The court stated the rule to be that

> "matters are . . . specifically exempted from disclosure by statute" only if a statute *either* identifies some class or category of items that Congress considers appropriate for exemption *or,* at least, sets out legislatively prescribed standards or guidelines that the Secretary must follow in determining what matter shall be exempted from disclosure. (Emphasis added).[11]

From this language, we infer that the Third Circuit would be satisfied that the phrase "applications for patents" sufficiently identifies the class of items Congress deems appropriate for exemption so that the absence of guidelines in § 122 for the exercise of the Commissioner's discretion would not be determinative.

Plaintiff, of course, argues that, where the administrator has unbridled discretion to disclose or not disclose a class of items, the (b)(3) exception should be unavailable regardless of how carefully such class is identified. But we are persuaded of the correctness of the Third Circuit view. The presence of guidelines for the exercise of discretion to withhold or disclose qualifies a statute to be the basis of a (b)(3) exception. The phrase "such special circumstances as may be determined by the Commissioner" is such a standard. It incorporates the then existing administrative standards for disclosure of patent applications embodied in Rule 14(a) and (b).[12] In turn, the standards found in Rule 14 are sufficiently specific that they meet the "specifically exempting" requirement of the (b)(3) exception. Since the legislative history is clear that § 122 was intended to codify the Patent Office rule of secrecy, whatever it may have been, we see no

[11] Slip Opinion at 3.

[12] 37 C.F.R. § 114(a), (b).

insuperable barrier to reading the guidelines for the exercise of the Commissioner's discretion to disclose back into the statute. We therefore hold that § 122 "specifically exempts" applications for patents from disclosure within the meaning of § 552(b)(3).

V.

Thus, we are brought to the ultimate question of how, in this case, to apply 5 U.S.C. § 552(a)(3) in the light of 5 U.S.C. § 552(b)(3) and 35 U.S.C. § 122. We begin by recognizing that in *Kewanee Oil Company* v. *Bicron Corporation*, —— U.S. ——, ——, 42 L.W. 4631, 4636 (May 13, 1974), the Supreme Court has recently stated:

> The mere filing of applications doomed to be turned down by the Patent Office will bring forth no new public knowledge or enlightenment, since under federal statute and regulation patent applications and abandoned patent applications are held by the Patent Office in confidence and are not open to public inspection. 35 U.S.C. § 122; 37 C.F.R. § 1.14(b).

While at first blush this sentence may seem to decide the instant case, we are persuaded that it has not, and that the issue is before us for initial adjudication.

Kewanee was a diversity action in which a manufacturer of synthetic crystals sought injunctive relief and damages under Ohio law against certain former employees and the corporation that they caused to be organized on the grounds that defendants had misappropriated plaintiff's trade secrets. The district court, applying Ohio law, granted relief, but the Court of Appeals reversed on the ground that Ohio's trade secret law conflicted with, and hence was preempted by, the federal patent laws. The Supreme

Court reversed the judgment of the Court of Appeals and reinstated that of the district court. The principal discussion in its opinion was about whether there was a conflict between the provisions and purposes of the federal patent laws and the Ohio law of trade secrets. It was with regard to a trade secret known not to be patentable that the Supreme. Court made the statement quoted to demonstrate that the Ohio law which protected such a trade secret did not conflict with federal patent law.

There is nothing in the opinion in *Kewanee* to indicate that the *legality* of suppressing all information contained in abandoned applications was either litigated or decided. The quoted statement appears to be nothing more than a factual recitation of the surface provisions of the existing statute and regulation. Indeed, the statement is not necessarily even one that § 122 prescribes a rule of confidence for abandoned patents. This is so because the statement speaks of both "patent applications" and "abandoned patent applications," citing § 122 and 37 C.F.R. § 1.14(b)—which relates only to abandoned patent applications—but *not* 37 C.F.R. § 1.14(a)—which relates to pending patent applications. It follows that the statement may be read to invoke only § 1.14 (b) of the regulations, and *not* § 122 of the statute, as support for its comment about the confidentiality of abandoned patent applications. Hence, we feel free to deal with the case on the merits as presenting a question of first impression; and, as we will show, we conclude that the statement in *Kewanee* is indeed the law with respect to abandoned applications.

VI.

In *Ethyl Corp.* v. *Environmental Protection Agency*, 478 F. 2d 47, 48–49 (4 Cir. 1973), affirming our prior

decision in *Welford* v. *Hardin*, 444 F. 2d 21, 25 (4 Cir. 1971), we said:

> The Freedom of Information Act was intended to express in statutory form the firm obligation of governmental agencies to make disclosure to "any person" of identifiable information and facts in their possession, limited only by specific exemptions. Specifically, it denied the federal agency any right to "refuse disclosure of materials covered by the Act for any reason other than one contained in the exclusionary section of the legislation." The legislative history of the Act makes it clear that the obligation to produce thereby mandated is to be construed *broadly* and the exemptions from such obligation *narrowly*. In short, the Act makes disclosure the rule and secrecy the exception. (Emphasis in original).[13]

This is the spirit in which we approach the main question and this is why, in order for a failure to disclose to be sustained under § 552(b)(3), there must be *strict* compliance with its requirement that a matter be "*specifically* exempted" from disclosure by statute. The language in § 122 creating confidentiality speaks of "[a]pplications for patents." The language is broad enough to include all categories of applications—pending, abandoned and granted—[14] and that

[13] *Ethyl Corp.* was decided after *Environmental Protection Agency* v. *Mink*, 410 U.S. 73 (1973). That it is in accord with controlling precedents is demonstrated by the characterization in the later decision of *Renegotiation Board* v. *Bannercraft Clothing Co., Inc.*, —— U.S. ——, —— (February 19, 1974)—"The Broad language of the FOIA, with its obvious emphasis on disclosure and with its exemptions carefully delineated as exceptions . . ."—in reaching the holding that FOIA does not limit the inherent powers of an equity court to grant relief.

[14] The disclosure of the essential portions of the applications for a patent when the patent is granted results from the provisions of 35 U.S.C. §§ 112 and 154 and not from the provisions of § 122.

would appear to be the legislative intent of Congress. Especially is this so when the adjective of qualification—"pending"—could so easily have been employed had Congress intended the operative effect of § 122 to be limited to pending applications for patents as plaintiff contends. Moreover, the concept of an abandoned application for a patent is a flexible one. Both 35 U.S.C. § 133 and 37 C.F.R. § 1.137 permit the revival of an abandoned application under certain circumstances. Thus, what may be an abandoned application, which plaintiff claims the right to inspect, may subsequently resume being a pending application, which plaintiff concedes is immune to inspection. When an "abandoned" application does not necessarily remain abandoned, it is difficult to give the language of § 122 the discriminating effect urged by plaintiff.

Lest the language of § 122 be not itself sufficient "specifically" to clothe abandoned patent applications with confidentiality, we turn to its legislative history. The enactment of § 122 was part of the overall revision and reenactment of the patent laws in 1952. Both the House and Senate reports state that "[s]ection 122 incorporates into the title the rule of secrecy of patent applications *which has existed in the Patent Office for generations.*" (Emphasis added). H. Report No. 1923, 82d Cong., 2d Sess. at 7 (1952); S. Report No. 1979, 82d Cong. 2d Sess. at 6 (1952). The fact is that, while the regulations of the Patent Office have spoken of pending and abandoned applications on a parity as to secrecy only since 1952, for *ninety* years prior thereto, and hence for the "generations" referred to in the legislative history of § 122, the practice of the Patent Office has been to treat them alike.

The text of the Patent Office rule in effect in 1952

(and also in effect at the present) is set forth in the margin.[15] It will be noted that subsection (a), with an exception not pertinent, states that "pending patent applications are preserved in secrecy," and subsection (b) states that "abandoned patent applications are *likewise* not open to public inspection" (emphasis added) except those referred to in a patent.[16]

The rule was promulgated December 31, 1948, to become effective March 1, 1949.[17] Prior to 1949, pending and abandoned applications were usually the subjects of separate rules but they were, for practical

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[15] 37 C.F.R. § 1.14. *Patent applications preserved in secrecy.*

(a) Except as provided in § 1.11(b) pending patent applications are preserved in secrecy. No information will be given by the Office respecting the filing by any particular person of an application for a patent, the pendency of any particular case before it, or the subject matter of any particular application, nor will access be given to or copies furnished of any pending application or papers relating thereto, without written authority in that particular application from the applicant or his assignee or attorney or agent of record, unless it shall be necessary to the proper conduct of business before the office or as provided by this part.

(b) Except as provided in § 1.11(b) abandoned patent applications are likewise not open to public inspection, except that if an application referred to in a U.S. patent is abandoned and is available, it may be inspected or copies obtained by any person on written request without notice to the applicant. Abandoned applications may be destroyed after 20 years from their filing date, except those to which particular attention has been called and which have been marked for preservation. Abandoned applications will not be returned.

[16] Until 1879, the Patent Office, in the examination of pending applications, cited abandoned applications as references. This practice was discontinued in 1879. The current practice of *not* citing abandoned applications as references is set forth in 37 C.F.R. § 1.108.

[17] 13 Fed. Reg. 9577 (1948).

purposes, treated alike. Pending applications have always been accorded secrecy;[18] abandoned applications were not given formal secrecy until 1949, although access to them was restricted after 1879, when the Patent Office abandoned the practice of citing abandoned applications as references in the examination of pending applications.[19] The degree of restriction is highly significant. An examination of the opinions of

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[18] A brief history of the rules granting secrecy to pending applications follows:

The first rule appeared in 1854, and it provided:

"Aside from the caveats, which are required by law to be kept secret, all pending applications are, as far as practicable, preserved in like secrecy. No information will therefore be given to those inquiring whether any particular patent is before the office, or whether any particular person has applied for a patent."

With renumbering and inconsequential editorial change, the 1854 rule continued until 1879. In that year, the rule was revised twice, the latter version being:

"Caveats and pending applications are preserved in secrecy. No information will be given without authority . . . unless it shall be necessary to the proper conduct of the business before the office, as provided by Rules . . . ."

In 1897, the rule was revised in a manner creating an apparent dichotomy of treatment of pending and abandoned applications. The 1897 rule read:

"Applications will be preserved in secrecy, except as provided in the interference rules; but copies of abandoned applications, upon petition therefor, for sufficient cause . . . will be furnished by the Commissioner."

The next revision occurred in 1916 and, except for a right of inspection of pending applications by the military for inventions having value in the prosecution of World War I, it continued unchanged until the present rule became effective in 1949. The essence of the 1916 rule read:

"Pending applications are preserved in secrecy. No information will be given without authority . . . unless it shall be necessary to the proper conduct of business before the office, as provided by Rules . . . ."

the Supreme Court of the District of Columbia and the opinions of the Commissioner of Patents fairly demonstrate that, aside from an interference proceeding in the patent office, only a defendant in an infringement suit could obtain inspection of one or more specific abandoned applications, but then only if they were applications of the plaintiff who sued him for infringement and the defendant could allege that they contained material relevant to his defense. See U.S. *ex rel. Pollok* v. *Hall,* 48 O.G. 1263 (Sup. Ct. D.C. 1888); *Ex parte Fowler* and *Fowler,* 49 O.G. 562 (1889) *aff'd sub nom., U.S. ex rel. Fowler* v. *Commissioner,* 62 O.G. 1968 (Sup. Ct. D.C. 1890); *U.S. ex rel. Bulkley* v. *Butterworth,* 81 O.G. 505 (Sup. Ct. D.C. 1897); *Ex parte Warner,* 96 OG. 1238 (1901; In re Dyer, 106 O.G. 1508 (1903); *In re Ashtabula Telephone Company,* 110 O.G. 860 (1904); *In re Buck,* 113 O.G. 1418 (1904); *In re Taupenot,* 113 O.G. 1418 (1904).

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[19] Prior to 1879, the rules of the Patent Office made abandoned patent applications freely available to the public. The first rule relating to inspection of abandoned applications was adopted in 1879, and it provided:

"Certified copies of the files in cases of rejected or abandoned applications may be furnished to applicants or to other persons when specifically ordered, but no inspection of such files, except by the applicants or their duly authorized attorneys, will be permitted."

This rule continued until 1946, when it was revised into the following form:

"Copies of the files of forfeited and abandoned applications may be furnished when ordered by the Commissioner. The requests for such copies must be presented in the form of a petition properly verified as to all matters not appearing of record in the Patent Office." (See Form ——).

The 1946 revision continued until it was supplanted by 37 C.F.R. § 1.14(b).

Thus, it appears that while the Patent Office had, for generations, maintained separate rules limiting public access to pending and abandoned applications respectively, the practical effect of the two rules was identical. Since we look to substance rather than form, we think the difference in nomenclature preserved by the Patent Office for many years is of little significance and thus we conclude that the legislative history of § 122 only reenforces the facial breadth of the legislative command that abandoned as well as pending patent applications are protected from general public disclosure.[20] Notwithstanding FOIA's strong policy of disclosure, we hold that mandatory disclosure of abandoned patent applications is foreclosed by § 122.

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[20] Our conclusion is in accord with the views of an authoritative commentator on the meaning and effect of § 122. The statement in the House and Senate Reports on H.R. 7794 that § 122 would codify "the rule of secrecy of patent applications which has existed in the Patent Office for generations" was undoubtedly derived from the testimony of Mr. Federico in the hearings on H.R. 3760, a prior version of H.R. 7794. Section 122 of H.R. 3760 is identical to § 122 of H.R. 7794, which was enacted as the present patent title. Mr. Federico had long been an examiner in the Patent Office and had assisted the committee staff in drafting H.R. 3760. Thus, it is significant that after the enactment of present § 122, Mr. Federico wrote that § 122 "makes no distinction between pending applications and abandoned applications . . ." Federico, Commentary on the New Patent Act, 35 U.S.C.A. § 1, 1, 36.

Although entitled to less weight, we note also the pendency in Congress of proposals to abolish the secrecy rule as to both pending and abandoned patent applications. Proposed legislative abolition of the rule may well stem from the legislative understanding that the rule exists. See H.R. 7111, § 122, 92d Cong., 1st Sess., 119 Cong. Rec. No. 61, at H2877 (April 17, 1973); S. 1321, § 122, 93d Cong., 1st Sess., 119 Cong. Rec. No. 45 at S5373 (March 22, 1973).

VII.

As a constitutional barrier to the conclusion we reach, plaintiff argues that § 122 and 37 C.F.R. §§1.14 (b) and 1.108 are unconstitutional. The claim that 37 C.F.R. §§ 1.14(b) and 1.108 are invalid is derivative of the claim that § 122 is invalid insofar as it exempts abandoned applications from public disclosure, and plaintiff advances three distinct theories to arrive at that conclusion. A related argument is that the district judge should have convened a three-judge court to pass upon plaintiff's constitutional contentions rather than to have decided them himself. We agree with the district court that plaintiff's constitutional contentions are lacking in merit, and indeed are so insubstantial that it was unnecessary to convene a three-judge court pursuant to 28 U.S.C. § 2282 to reject them.[21] We turn to plaintiff's several arguments.

First, plaintiff relies upon Supreme Court decisions which say that the Patent Clause of Art. I is at once a conferral of power and a limitation upon the power conferred. Plaintiff contends that abandoned patent applications are evidence of the nature and scope of prior art and the level of ordinary skill therein, particularly when the Patent Office has rejected an application as not representing a significant advance over the prior state of the art at the time of the invention; and therefore a rule denying public access to abandoned patent applications prevents the efficient use of evidence material to the resolution of questions of patentability *in the constitutional sense.* It is argued that since the rule of secrecy is likely to lead to uncon-

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[21] *Ex parte Poresky*, 290 U.S. 30 (1930); *Bailey* v. *Patterson*, 369 U.S. 31 (1962); *Rosado* v. *Wyman*, 397 U.S. 397 (1970); *Maryland Citizens for A Rep. Gen. A.* v. *Governor of Md.*, 429 F.2d 606 (4 Cir. 1970).

stitutional adjudications that extend patent protection to inventions that are not patentable constitutionally, the secrecy rule is itself unconstitutional.

We do not agree. If Congress, in purported exercise of the Patent Power, attempts to extend patent protection to an item that is not a "discovery" within the meaning of the Patent Clause, such exercise of power would probably be unconstitutional. Although the Supreme Court does not appear to have invalidated any patent legislation on this theory, it seems clear that the Court believes that patentability standards such as non-obviousness—the requirement that the invention be "unobvious to one of ordinary skill in the art at the time it was made"—have a constitutional dimension.[22] But there are several answers to the contention. In the first place, 35 U.S.C. § 102 which specifies the type of prior art which will prevent issuance of a patent, or render an issued patent invalid, does not specify abandoned applications as "prior art." Brown v. Guild (The Corn Planter Patent), 90 U.S. 181, 210, 211 (1874), holds that an abandoned application, *per se,* cannot be the basis for holding a patent invalid because the application represents nothing more than an abandoned experiment. See also 1 Deller's Walker on Patents, 309 (1964). The rule has been criticized but not modified. Milburn Co. v. Davis Bournonville Co., 270 U.S. 390 (1926). But, where the concept of an abandoned application has been published or practiced so as to become "prior art," § 122 would not prevent a litigant in a suit over the validity of a patent from discovering any relevant and material abandoned patent applications. The exception in § 122 seems to be designed to meet this purpose.

[22] Graham v. John Deere Co., 383 U.S. 1 (1966); Anderson's Black Rock v. Pavement Salvage Co., 396 U.S. 57 (1969).

At best, full disclosure of abandoned patent applications would only facilitate the marshalling of evidence relevant to patentability that may be found in abandoned patent applications. Public disclosure of abandoned applications would probably permit the patent bar to develop expertise concerning what is contained in the mass of abandoned patents; patent attorneys might more readily be able to develop knowledge of what to look for and where to look for it under a system of public disclosure, in contrast to the present secrecy system where they must, indeed, start from scratch in their discovery in each case. But we doubt that the increased likelihood of correctness in adjudications about the validity of patents would be substantial. Furthermore, we do not think that a statute can be unconstitutional for no other reason than that it has some tendency to hamper the correct resolution of constitutional issues before the courts for adjudication.

Plaintiff's second constitutional theory relies upon the substantive due process clause of the fifth amendment. It is conceded that one of the purposes of the secrecy rule is to obviate the risk that, through publication, an applicant for a patent may lose rights arising under state trade secret law. Plaintiff says it is likely that many of the trade secrets embodied in abandoned patent applications are constitutionally unpatentable; and, if that be so, for the state to extend monopoly protection under its trade secret law to such inventions violates substantive due process.

The short answer to this argument is the recent decision in *Kewanee Oil Co.* v. *Bicron Corp., supra.* That case extended the holding in *Goldstein* v. *California,* 412 U.S. 546 (1973), that the power of Congress to protect writings by granting copyrights was not exclusive and that the states were not forbidden

to encourage and protect the writings of those within their borders, to intellectual property in inventions, i.e., trade secrets. *Kewanee* held that "[s]tates may hold diverse viewpoints in protecting intellectual property relating to invention as they do in protecting the intellectual property relating to the subject matter of copyright. The only limitation on the states is that in regulating the area of patents and copyrights they do not conflict with the operation of the laws in this area passed by Congress . . . ." —— U.S. at ——. Thus, the states may protect trade secrets, and we perceive no violation of the fifth amendment in federal forebearance to permit that power to be exercised.

Finally, plaintiff argues that neither Congress nor the Commissioner may validly assist patent applicants to preserve their state created trade secret rights in unpatentable ideas because of the Patent Clause of the Constitution. Again, the argument is that the states may not create trade secret rights in unpatentable ideas and that therefore Congress and the Commissioner may not assist private persons to maintain any such rights. Again the answer is *Kewanee*. The only possible constitutional bar to such state action stems, not from the Patent Clause, but from the Supremacy Clause. Any preemption of state authority is to be looked for, not in the constitutional grant of the Patent Power to Congress, but in the exercise of that power; and *Kewanee* holds that Title 35 does not of itself preempt state regulation and protection.

Since plaintiff's constitutional arguments are so insubstantial, we are satisfied that the district court had power, as a single judge, to decide her constitutional claims.

Affirmed.

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